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EXAMINER

BASHORE, WILLIAM L

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 19

Application Number: 09/192,014
Filing Date: November 13, 1998
Appellant(s): KLOTZ ET AL.

Patrick J.S. Inouye
For Appellant

EXAMINER'S ANSWER

MAILED
JAN 28 2004
Technology Center 2100

This is in response to the appeal brief filed November 6, 2003.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

Art Unit: 2176

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that the appealed claims do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

Art Unit: 2176

(9) Prior Art of Record

6,192,165	IRONS	2-2001
5,998,752	BARTON ET AL.	12-1999

"Xerox touts DataGlyphs for paper data", Seybold Report on Desktop Publishing, Vol 9, no. 5 (1996), pp.1-3

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, are rejected under 35 U.S.C. 103(a) as being unpatentable over Irons, U.S. Patent No. 6,192,165, filed December 30, 1997, and issued February 20, 2001, in view of *Xerox touts DataGlyphs for paper data* (hereinafter Xerox), Seybold Report on Desktop Publishing, Vol. 9, No. 5, copyright 1996, pp.1-3, downloaded on 12/6/2001 from <url: http://www.seyboldseminars.com/seybold_report/reports/D0905001.HTM>.

In regard to independent claim 1, Irons teaches a scanner for scanning a document along with an affixed label (Irons column 8 lines 1-10; compare with claim 1 "*A method for processing....comprising the steps of*", and "*scanning the document to produce an image representative of the document*").

Art Unit: 2176

Irons teaches subsequent to scanning, locating and decoding the digitized label from said document, said label associated with a user ID (Irons column 8 lines 4-10, column 11 lines 30-36, Figure 5; compare with claim 1 “*locating the user interface tag in the image*”, “*decoding data represented in the user interface tag*”, and “*...a user identity...*”).

Irons teaches storing said number as an index (linked) to a database for facilitating later retrieval of a document onto an output device, as well as a document invoice indicative of a service (Irons column 7 lines 55-61, Figure 8, 9). Irons does not specifically teach performing a service associated with document data. However, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Irons, because Irons teaches that the machine readable portion of a label may contain additional information, such as information on document disposition (Irons column 11 lines 22-26; compare with claim 1 “*associating the data with a service....performing the specified service*”), suggesting a performed service, and providing the advantage of disposition associated with the invoices of Irons Figure 8, 9.

Irons teaches a scanned office form (an invoice) with a machine readable code in the upper right corner of said invoice, said code can contain additional information regarding document disposition (see above). Said invoice also contains images indicating two handwritten signatures, as well as a bulleted area indicating type of payment in the lower left portion of said invoice (Irons Figure 9 item 920). Irons does not specifically teach performing a service on the image of the scanned form. However, Xerox teaches DataGlyphs, which can encode and read machine readable information (including executable commands) applied to office forms, using SmartPaper Controls (Xerox page 2 section “SmartPaper Controls”). SmartPaper can perform the service of electronically verifying whether a form has been signed (Xerox page 2 section “Signature regions”). Since multiple signatures are typically applied on said invoice at different times (i.e. supervisors and sales people in different buildings), the DataGlyphs are updated accordingly. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Xerox’s signature verification within Iron’s machine readable code, providing Irons the benefit of signature verification, since verifying the presence of handwritten signatures has a necessary bearing on the disposition of an invoice form (compare with claim 1 “*performing the specified service on the image representative of the document.*”).

In regard to dependent claims 2-3, Irons teaches identification of a machine readable ID image bar code label (Irons Figure 4; compare with claim 2 “*identifying a connected component in the image*”) Irons teaches the use of high density symbologies for encoding an image file (Irons column 11 lines 18-23). Irons does not specifically teach finding extreme points, determination of a diagonal length, and a rectangle including said points, as well determination of a lattice of glyphs, a seed glyph, identifying a rotation, and converting said glyphs to binary data. However, Xerox teaches DataGlyph coding, which comprises blocks (rectangles) of data represented as diagonal lines, the analyzed slope of which (either left or right) are indicative of binary data within an analyzed block. The data is grouped into blocks to which framing is added. In addition, said coding is embedded in an error-correcting code utilizing redundant bits, and encoded bytes reordered in a pseudorandom way (requiring a seed) (Xerox pages 1-3, especially bottom of page 1 to top of page 2; compare with claims 2-3). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Xerox to Irons, because of Xerox’s taught advantage of DataGlyphs, providing the labels of Irons a symbology especially designed for the rigors of a hardcopy environment (Xerox page 2, near top).

In regard to dependent claim 4, Irons teaches extracting a user identity code from an analyzed label, said code associated with a database for additional information (Irons column 8 lines 5-14, column 11 lines 29-40, Figure 5).

In regard to dependent claims 5-6, Irons teaches storing a code as an index (linked) to a database for facilitating later retrieval of a document onto an output device, as well as a document invoice indicative of a service (Irons column 7 lines 55-61, Figure 8, 9). Irons does not specifically teach extracting a service code. However, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Irons, because Irons teaches that the machine readable portion of a label may contain additional information, such as information on document disposition (Irons column 11 lines 22-26; compare with claims

5-6, suggesting a service (or invoice) code associated with said invoice, and providing the advantage of an index code associated with the invoices of Irons Figures 8, 9.

Claims 11, 14-15, are rejected under 35 U.S.C. 103(a) as being unpatentable over Irons, U.S. Patent No. 6,192,165, filed December 30, 1997, issued February 20, 2001, in view of Barton et al. (hereinafter Barton), U.S. Patent No. 5,998,752, filed March 16, 1998, issued December 7, 1999.

In regard to dependent claim 11, Irons teaches printing a document label comprising a machine-readable data code, said label is associated with, and affixed to a hardcopy document prior to scanning of said document, said code incorporating a user identity code (Irons column 11 lines 4-15, 27-41, column 12 lines 41-60; compare with claim 11 "*A user interface tag...code representative of a user's identity*").

Irons does not specifically teach a service code for specifying a service to be performed on a hardcopy document. However, Barton teaches a mail processing system including sorting stations for various pieces of mail. The sorting of a mail item is dependent upon the intended address of a mail item, as well as class of service, etc. (Barton column 1 lines 5-8, 59-62, column 2 lines 1-10). A bar code can be applied to a mail item, uniquely identifying said item (Barton column 2 lines 11-14, 55-58). It is to be noted that a bar code can be applied to a post card, since a post card is a known form of a hardcopy document, as well as a known form of mail item. Barton teaches printing a routing code (a machine-readable form of the destination address) onto said mail item (Barton column 4 lines 64-67, column 5 lines 1-5). The routing code specifies a service to be performed on a mail item (i.e. a post card), since the routing code is used by the sorting system (and by a post office in general), to direct said mail item to a particular destination (compare with claim 11 "*a service code specifying a service to be performed on said hardcopy document.*"). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Barton's routing code to Irons bar code information,

Art Unit: 2176

providing Irons the capability of mailing a printed copy of an invoice to a destination (Irons Figure 9) using a routing code.

In regard to independent claim 14, Irons teaches creating user interface tags associated with documents (Irons Abstract; compare with claim 14 *"An apparatus for....comprising:"*).

Irons teaches receiving information (user ID) reflective of a user, said user ID used for creating a unique document number (identity code) (Irons column 11 lines 27-42, Figure 5; compare with claim 14 *"an identity processor adapted to receive user information and create an identity code"*).

Irons teaches storing said number as an index to a database (Irons column 7 lines 50-60; compare with claim 14 *"a user information database....with the identity code"*).

Irons teaches printing a user interface sticker comprising a machine readable identity code (Irons column 12 lines 41-50, Figure 4; compare with claim 14 *"an output device capable of printing a tag bearing....representative of the identity code"*).

Irons does not specifically teach a service code for specifying a service to be performed on a hardcopy document. However, Barton teaches a mail processing system including sorting stations for various pieces of mail. The sorting of a mail item is dependent upon the intended address of a mail item, as well as class of service, etc. (Barton column 1 lines 5-8, 59-62, column 2 lines 1-10). A bar code can be applied to a mail item, uniquely identifying said item (Barton column 2 lines 11-14, 55-58). It is to be noted that a bar code can be applied to a post card, since a post card is a known form of a hardcopy document, as well as a known form of mail item. Barton teaches printing a routing code (a machine-readable form of the destination address) onto said mail item (Barton column 4 lines 64-67, column 5 lines 1-5). The routing code specifies a service to be performed on a mail item (i.e. a post card), since the routing code is used by the sorting system (and by a post office in general), to direct said mail item to a particular destination (compare with claim 14 *"a service to be performed on a document to which said user interface tag is affixed."*). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Barton's routing code to Irons bar code information,

Art Unit: 2176

providing Irons the capability of mailing a printed copy of an invoice to a destination (Irons Figure 9) using a routing code.

In regard to independent claim 15, Irons teaches a scanner for scanning a document along with an affixed label (Irons column 8 lines 1-10; compare with claim 15 "*a scanner adapted....of the document*").

Irons teaches subsequent to scanning, identifying and decoding the digitized label from said document (Irons column 8 lines 4-10; compare with claim 15 "*an action processor adapted to identify....in the user interface tag*").

Irons does not specifically teach a service code for specifying a service to be performed on a hardcopy document. However, Barton teaches a mail processing system including sorting stations for various pieces of mail. The sorting of a mail item is dependent upon the intended address of a mail item, as well as class of service, etc. (Barton column 1 lines 5-8, 59-62, column 2 lines 1-10). A bar code can be applied to a mail item, uniquely identifying said item (Barton column 2 lines 11-14, 55-58). It is to be noted that a bar code can be applied to a post card, since a post card is a known form of a hardcopy document, as well as a known form of mail item. Barton teaches printing a routing code (a machine-readable form of the destination address) onto said mail item (Barton column 4 lines 64-67, column 5 lines 1-5). The routing code specifies a service to be performed on a mail item (i.e. a post card), since the routing code is used by the sorting system (and by a post office in general), to direct said mail item to a particular destination (compare with claim 15 "*said information including information indicating a service to be performed on said hardcopy document.*"). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Barton's routing code to Irons bar code information, providing Irons the capability of mailing a printed copy of an invoice to a destination (Irons Figure 9) using a routing code.

Irons teaches storing said number as an index (linked) to a database for facilitating later retrieval of a document onto an output device (Irons column 7 lines 55-61; compare with claim 15 "*a device operated by the....represented in the user interface tag.*").

(11) Response to Argument

Page 6 to top of page 8 of Appellant's brief (hereinafter "the brief") substantially comprises a description of the cited art of record (Irons and Xerox). Beginning on page 8 of the brief, Appellant argues the following issues, which are accordingly addressed below.

a *"Irons does not teach embedding service information in a tag to specify a service to be performed on the document"* (page 8, at bottom of the brief, repeated on page 10), also

"In addition, Irons teaches a designating disposition method, which is a necessary step in the archiving process, but is not a service to be performed on a hardcopy document. The embedded instruction code merely provides information about how, where or when to dispose a document instead of calling for the services to be performed on the original document." (page 9, near top, of the brief).

The examiner respectfully disagrees. Irons teaches a document invoice (Irons Figures 8, 9). Irons teaches that the machine readable portion of a label (the embedded information) may contain additional information, such as information (to be provided to a user) regarding document disposition (Irons column 11 lines 22-26, see also Irons column 12 lines 44-52). Additionally, it is respectfully noted that the hardcopy of Irons can be retrieved again as needed (see Irons column 13 lines 5-10, also Figure 7 item 795).

It is respectfully submitted that since Appellant does not specifically define a type of "service" within the claimed limitations, it is obvious to the skilled artisan that (embedded) information regarding document disposition can be a form of service to a user, because it serves to provide information to the user regarding what is to happen to said document (i.e. how the document is to be handled, or disposed of). Although Appellant gives examples of services (i.e. "scan and send via e-mail" - page 9 at top, of the brief), it is respectfully

submitted that Appellant is arguing the disclosure, not the claimed limitations, and is reading said disclosure into the claims.

b. *“Xerox does not teach or suggest a method for processing a document based on information in a user interface tag. Specifically, Xerox does not teach or suggest embedding service codes in the user interface tags for a service to be performed on the document”* (page 9, at middle, of the brief).

The examiner respectfully disagrees. The rejection of representative claim 1 recites that Irons does not specifically teach performing a service on the image of the scanned form. Xerox teaches DataGlyphs, which can encode and read machine readable information (including executable commands) applied to office forms, using SmartPaper Controls (Xerox page 2 section “SmartPaper Controls”). SmartPaper can perform the service of electronically verifying whether a form has been signed (Xerox page 2 section “Signature regions”). Since multiple signatures are typically applied on said invoice at different times (i.e. supervisors and sales people in different buildings), the DataGlyphs are updated accordingly.

It is respectfully submitted that Irons teaches a service (as explained above). The examiner uses the Xerox reference to specifically teach performing a service on the image of the scanned form. Xerox teaches analysis of its DataGlyphs as applied to a document. Since Irons teaches bar coding images along with signatures, Irons can benefit from Xerox’s DataGlyphs to verify Irons’s signatures (as well as verifying other document related data).

c. *“Taken together, both Irons and Barton references fail to teach all of the claim limitations of claim 11. Neither Irons nor Barton teaches a user interface tag encoded with service information to be performed on the document”* (page 12 of the brief).

The examiner respectfully disagrees. Appellant’s arguments are substantially similar to those previously presented. Please see responses a and b, above.

In addition, the examiner uses Barton to teach a service on a hardcopy document. Barton teaches a mail processing system including sorting stations for various pieces of mail. The sorting of a mail item is dependent upon the intended address of a mail item via the use of a printed routing code (a machine-readable form of the destination address). The routing code specifies a service to be performed on a mail item (i.e. a post card), since the routing code is used by the sorting system (and by a post office in general), to direct said mail item to a particular destination, and is applied to Irons’s document, the hardcopy of which can be retrieved again as needed (see Irons column 13 lines 5-10, also Figure 7 item 795).

Appellant’s arguments from page 12 (at bottom) to page 14 of the brief are substantially similar to those previously presented. Accordingly, the examiner’s responses to arguments a, b, and c apply here as well.

Art Unit: 2176

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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January 20, 2004


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